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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,894	03/31/2000	Marvin J. Doman	S-90,669	7348

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UNITED STATES DEPARTMENT OF ENERGY
1000 INDEPENDENCE AVENUE, S.W.
ATTN: GC-62 (HQ) MS 6F-067
WASHINGTON, DC 20585-0162

EXAMINER

BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779894

Applicant(s)

Doman et al

Examiner

Behrend

Group Art Unit

3641

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/3/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above claim(s) 6-9 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5, 10-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3641

1. This is in response to the amendment filed 6/5/03.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 10, 15, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kessinger.

The shear ring reads on element 80 which is welded to shield plug 72 at 84 (col. 4 lines 50+) and to the canister shell at 68 (col. 5 lines 46+). Note also that cover 114 is welded to element 128 at edge 132. Element 128 is welded to the canister shell at lower edge 130 (col. 6 lines 18+).

Applicants' arguments are unpersuasive of any error.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that applicants claimed "shear ring" is not flexible, that applicants claimed "shear ring" is designed to fail under (some unknown and unspecified) excess load, that applicants claimed "shear ring" provides a load path to guide the direction of shearing, etc., are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read onto the claims. See *In re Van Geuns*, 26 USPQ2d 1057.

It is not seen how applicant can properly argue that his shear ring is "not flexible", especially since even applicant himself in the second paragraph on page 4 of the 6/5/03 response admits that shear rings can be flexible!

Indeed, none of the features argued by applicant for his alleged "shear ring" are even disclosed in applicants specification!

Instead, the specification on page 9 line 18 to page 10 line 3 states that the "shear ring 30" must be capable of bearing the full load of a loaded canister, with or without the presence of seal welds 31 and 33.

The only feature that applicants own specification recites about “shear ring” 30, is that it is a load bearing member (e.g. see page 9 of the specification).

Thus, any ring which even partially bears a load would meet applicant disclosed function (and claimed in claims 15 and 16) of a load bearing member.

Kessinger in the sentence bridging cols. 5 and 6 states that element or ring 80 “accommodates minor movement of cover 72 with respect to mouth region 44 without unduly straining the welded seal”.

This referred to movement of cover 72 present a “load” on ring 80.

Thus, ring 80 of Kessinger is considered to be a “load bearing” element (as recited in applicants claims 15 and 16).

Furthermore, it inherently follows that, since element or ring 80 of Kessinger will accommodate minor movement of cover 72 with respect to mouth region 44 without unduly straining the welded seal, a major movement (or anything other than a minor movement) will unduly strain the welded seal and thus cause shearing thereof.

As to features which are considered as being inherent in a reference note the case law of In re Ludtke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al, 195 USPQ 430, and also In re Brown, 173 USPQ 685, 688.

5. Claims 2-4, 10-16 are rejected under 35 U.S.C 103(a) as being unpatentable over Kessinger in view of applicants own admission of prior art in the specification or, Hallet et al.

Art Unit: 3641

Kessinger has been discussed above. Claims 2 and 3 recite a multi-piece construction rather than a single unitary construction. However, such is admitted by applicant in the 8/12/02 response to be an obvious modification.

Claims 2 and 3 are further considered obvious in view of the case law stating that a one piece construction versus a multi-piece construction is an obvious engineering choice (see MPEP 2144.04, part V).

As to claim 4, Kessinger shows the cover plate welded to the canister shell. It would have been prima facie obvious to have also welded the cover plate to the shield plug because such is no more than an art recognized conventional expedient.

It is conventional in the art and hence obvious on its face to provide structure for leak testing as evidenced for example by the teachings thereof in either Hallet et al or applicants specification on page 6 lines 15+.

Applicant arguments are unpersuasive.

Initially, it is noted that applicant has not rebutted the examiner's position that it would have been obvious to have formed element 80 of Kessinger as a multi-piece construction rather than a single unitary construction, in view of applicants admission in the 8/12/02 response that a multi-piece construction is an obvious modification of a single unitary construction.

Applicants arguments concerning the examiner's reliance on MPEP 2144.04 part V has been considered but they are not persuasive. The features argued by applicant (e.g. that element 80 of Kessinger does not function as a shear ring, that Kessinger's elements 88, 90 do not provide a containment boundary in the canister) are not seen as

being determinative of the applicability of MPEP 2144.04 part V to the teachings of Kessinger as set forth above by the examiner, nor, has applicant shown why these features should be so determinative.

6. On page 6 of the 6/5/03 response, applicant questions why claim 6 was withdrawn from consideration since it reads on elected specie S.

As stated in section 1 on page 2 of the 3/21/03 Office action, applicant in the 8/12/02 response elected specie S with traverse, stating that species R and S are obvious variants of one another, and, based on said statement by applicant, the election of species requirement between species R and S was withdrawn.

Claim 6 was withdrawn from consideration, as it is specific to non-elected specie B (see page 3 of the 9/6/01) Office action).

7. At the bottom of page 6 of the 6/5/03 response, applicant states that the election of Group I and specie A was actually made with traverse, not without traverse as indicated by the examiner.

However, while the 3/6/02 response does contain the words "Applicants provisionally elect, with traverse, the claims of Group I, claim 1-6, and new claims 10-14. Further, Applicant provisionally elect the species of claims 1-5", the 3/6/02 response did not set forth any reasons, etc., for the traversal. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election was treated as an election without transverse (MPEP § 818.03(a)).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3641

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'H. Behrend', with a large, sweeping loop at the end.

**HARVEY E. BEHREND
PRIMARY EXAMINER**

Behrend/kn
August 18, 2003